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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,536	04/02/2001	Ergin Atalar	SUW-009.01	9438

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FOLEY HOAG, LLP
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EXAMINER

ROBINSON, DANIEL LEON

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 04/07/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,536

Applicant(s)

ATALAR ET AL.

Examiner

Daniel I. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 55-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-25, 27-34, 40-43, 45 and 47-54 is/are rejected.
- 7) ☐ Claim(s) 5, 11, 26, 35-39, 44 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>many</u> . | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

Applicant's election without traverse of Group I, Species A, Claims 1-54 in Paper No. 14 is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 8, 10, 31, 34, 40-43, and 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lima et al.(U.S.Pat.6,408,202) in view of Chapelon et al.(U.S.Pat.5,355,087). Lima discloses a transesophageal magnetic resonance analysis method and apparatus that shows many of the features of the claimed invention but fails to show explicitly an endourethral imaging device. Chapelon discloses a therapy and imaging probe and therapeutic treatment apparatus that explicitly shows an endourethral imaging apparatus. It would have been obvious to one of ordinary skill in the art to use an endourethral apparatus so prostate tissue can be removed.

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Claims 2, 12-25, 27-30, 33, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lima in view of Chapelon and further in view of Derby et al.(U.S.Pat.5,379,767). Lima in view of Chapelon does not show a flexible circuit board. Derby discloses an MRI RF coil using zero pitch solenoidal that shows using a flexible circuit and a two coil quadrature coil assembly. It would have been obvious to one of ordinary skill in the art to use a flexible circuit, because the circuit can be folded into a cylinder, and a quadrature coil assembly because the coil assembly can be used advantageously at low frequencies.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lima in view of Chapelon as applied to above, and further in view of Dumoulin(U.S.Pat.6,054,858).

The modified Lima reference does not show a series and parallel capacitor relationship or a pin diode in the circuit. Dumoulin discloses a method to automatically tune MRI RF coils that shows a series and parallel capacitor circuit and a pin diode. It would have been obvious to one of ordinary skill to incorporate these features in to the modified Lima reference because the capacitor arrangement allows for switched variations while the pin diode has extremely low forward biased resistance.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Lima reference as applied to above, and further in view of McKinnon. The modified Lima reference does not show an inflation balloon. McKinnon discloses an insertion guidewire

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antenna that shows using an inflation balloon. It would have been obvious to one of ordinary skill in the art to use an inflation balloon with the modified Lima reference so as to prevent motion of the device.

Allowable Subject Matter

Claims 5, 11, 26, 35-39, 44, and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Robinson whose telephone number is 703 306-9043. The examiner can normally be reached on M-F 5:30am-2:30pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL I. ROBINSON
PATENT EXAMINER
TELEPHONE 703-306-9043
